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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,284	06/23/2003	Edward Michael Hansburg	1521-261U1	9122
570	7590	10/15/2004		
AKIN GUMP STRAUSS HAUER & FELD L.L.P. ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103-7013				
			EXAMINER HAMDAN, WASSEEM H	
			ART UNIT 2854	PAPER NUMBER

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,284

Applicant(s)

HANSBURG, EDWARD MICHAEL

Examiner

Wasseem H Hamdan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 and 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 9-12 rejected under 35 U.S.C. 103(a) as being unpatentable over Estabrooks (US Patent (6,633,740 B2) in view of Ohshio et al. (US Patent 6,557,795 B1), and further in view of Kobayashi et al. (US Patent 5,008,710).

Regarding claim 9, Estabrooks discloses a system for continuous printing [column 7, lines 41-47], the system comprising:

a sheet printer [21; 77] which receives sheets of print media and outputs printed-on sheets of the print media [FIG. 3],

an edge sensor [32; 40] which senses a leading edge of each of the printed-on sheets when output from said printer [column 11, lines 38-39];

a controller [51] which receives an output signal from said edge sensor [signal line between 40 and 51] indicating the detection of the leading edge and synchronizes, based upon the output signal, said sheet printer [20; 51; column 12, lines 54-57];

Estabrooks discloses the essential elements of the claimed invention except for a rewind to cause a trailing edge and the leading edge of each successive sheet received by said rewind to abut one to the other on the rewind. Ohshio et al. teaches a rewind [7] to cause a trailing edge

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[FIG. 5 (the second rectangle from the top)] and the leading edge [FIG. 5 (the top rectangle)] of each successive sheet received by said rewind to abut one to the other on the rewind [column 36, lines 1-2. Ohshio et al. discloses “narrowing spatial intervals between sheets arranged end to end in the winding”, i.e. minimizing the space between sheets. However a person having ordinary skill in the art at the time of the invention was made would find it obvious to make the space zero between sheets or abut one to the other (sheet) for the purpose of saving space and eventually store more sheets on the rewind. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Estabrooks by including a rewind to cause a trailing edge and the leading edge of each successive sheet received by said rewind to abut one to the other on the rewind, since Ohshio et al. teaches “narrowing spatial intervals between sheets arranged end to end in the winding”, which means minimizing the space between sheets which could lead to abut the sheets one to the other, and hence would be beneficial for the purpose of handling the final product such as storage and or shipping to make the final product ready for the next step of handling the final product.

Estabrooks and Ohshio et al. together disclose the essential elements of the claimed invention except for a rewind, which receives the printed-on sheets output from said printer. Kobayashi et al. teaches a rewind which receives the printed-on sheets output from said printer [72; column 4, lines 39-40]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to further modify the teachings of Estabrooks by including a rewind which receives the printed-on sheets output from said printer, since it would

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be beneficial for the purpose of handling the final printed product such as storage and or shipping.

Regarding claim 10, Estabrooks discloses the essential elements of the claimed invention except for wherein said sheet binder attaches the successive sheets one upon the other. Ohshio et al. teaches wherein said sheet binder attaches the successive sheets one upon the other [column 37, line 67; column 38, lines 1-3]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Estabrooks by including wherein said sheet binder attaches the successive sheets one upon the other, since having a sheet binder attaches the successive sheets one upon the other would be beneficial for the purpose of keeping the sheets together for later use, especially when they are unwound from the feed. Ohshio et al. is silent about a sheet binder interposed between said sheet printer and said rewind, but it is obvious to have a sheet binder interposed between said sheet printer and said rewind, because the process of binding has to be done after printing and before winding. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Ohshio et al. by including a sheet binder interposed between said sheet printer and said rewind, since it would be beneficial for making sure that the sheets are binded together after printing, so they become a final product to store and transport to the costumer.

Regarding claim 11, Estabrooks discloses wherein said sheet printer is an electrophotographic printer [column 1, line 14].

Regarding claim 12, Estabrooks discloses further including a cutter which forms the sheets of print media by cutting [15] one of roll [10]

3. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Estabrooks (US Patent 6,633,740 B2) in view of Ohshio et al. (US Patent 6,557,795 B1) and Kobayashi et al. (US Patent 5,008,710) as applied to claims 9-12 above, and further in view of applicant admitted prior art (Okidata Corporation).

Estabrooks, Ohshio et al. and Kobayashi et al. together disclose the essential elements of the claimed invention except for wherein the sheet printer is capable of printing on sheets at least as long as about 47 inches. Applicant admitted prior art (Okidata Corporation) teaches that the sheet printer is capable of printing on sheets at least as long as about 47 inches [specification page 4, lines 26-28]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to further modify the teachings of Estabrooks by including that the sheet printer is capable of printing on sheets at least as long as about 47 inches, since it would be beneficial for the purpose of meeting specific application that require a sheet about 47 inches long.

Response to Arguments

4. Applicant's arguments filed on 09/13/2004 have been fully considered but they are not persuasive. The amendment is insufficient to over come the prior art of record.

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Applicant's remarks filed on page 7, that "A teaching of narrowing the space between sheets is not the same as a teaching for the sheets to touch. Further, narrowing the space between the sheets to "almost zero" is not the same as requiring the sheets to touch." Ohshio et al. discloses "narrowing spatial intervals between sheets arranged end to end in the winding", i.e. minimizing the space between sheets. However a person having ordinary skill in the art at the time of the invention was made, would find it obvious to make the space zero between sheets (because minimizing the distance between sheets, would lead to having the sheets touching each other) for the purpose of saving space and eventually store more sheets on the rewind, and handling the final product such as storage and or shipping to make the final product ready for the next step of handling the final product.

In response to the applicant argument on page 7, that "Kobayashi et al. is directed to a paper feeder of a label printer which prints on continuous printing paper (col. 1, lines 6-11). Consequently, the rewind 72 receives continuous printing paper and not separate sheets of printed-on paper as recited in amended claim 9." The argument is moot since Kobayashi et al. Was introduced only to show the teaching of the "rewind". Therefore the rejection is proper.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as set forth in the office action mailed on 6/10/2004, on pages 3 and 4 the proper

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motivation to combine Estabrooks in view of Ohshio et al., and further in view of Kobayashi et al.

In response to the applicant argument on pages 7 and 8, that “Ohshio et al. does not teach or suggest applying the method of storing veneer with narrowed spaces between sheets to the output of a printer. Kobayashi et al., while teaching the use of a rewind to a printer, teaches the use only in respect to receiving continuous printing material.” The argument is moot since it was only used in the motivation statement so as why it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to further modify the teachings of Estabrooks as set forth in the office action. With the broadest reasonable interpretation of the instant application’s claimed limitation, Estabrooks in view of Ohshio et al., and further in view of Kobayashi et al. read on the claim language. Therefore the rejection is proper.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wasseem H Hamdan whose telephone number is (571) 272-2166. The examiner can normally be reached on M-F (first Friday off) 6:30 AM- 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wasseem H. Hamdan

October 5, 2004


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